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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,708	03/16/2004	Hiroshi Gotoh	R2184.0306/P306	1766
24998 7590 03/30/2007 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER SANDERS, AARON J	
			ART UNIT	PAPER NUMBER
			2168	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/30/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/800,708	Applicant(s) GOTOH, HIROSHI	
	Examiner Aaron J. Sanders	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 February 2007 has been entered.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: A Client/Server System and Method for Authorizing a Removable Storage Medium Based on Usage Information.

### ***Claim Rejections - 35 USC § 112 First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 5, 7, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the claimed invention relies on the step of reproducing information recorded on a removable storage medium. "Reproduce" has a very broad definition, and it is not clear from the instant specification how the Applicant is using the term. It is not clear what information is being reproduced, or to where it is being reproduced.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3 are directed to a method of reproducing information in a client/server system. Claims 5 and 6 are directed to a server. Claims 7, 8, and 10 are directed to a computer-readable recording medium. The claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomena) since it fails to produce a useful, concrete, and tangible result.

As per claims 1-3, 5-8, and 10, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulation of data. More specifically, the claimed subject matter provides for reproducing information recorded on a removable storage medium. "Reproduce" has a very broad definition, and it is not clear from the instant specification how the Applicant is using the term. It is not clear what information is being reproduced, or to where it is being

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reproduced. Thus, this produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

As per claims 5-8, the claimed subject matter does not produce a useful result because the claimed subject matter fails to sufficiently reflect at least one practical utility set forth in the descriptive portion of the specification. More specifically, while the described practical utility (utilities) is (are) directed to reproducing information, the claimed subject matter relates ONLY to a computer-readable recording medium.

As per claims 5 and 6, the server does not require any hardware, making it software *per se*. As such, the instant claims are non-statutory.

As per claims 5-8 and 10, it appears that Applicant is trying to claim a manufacture. However, data manipulation is not a manufacture because there is no physical result produced from physical materials. As such, the instant claims are non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Takano, U.S. P.G. Pub. 2002/0082917.

As per claims 1-3, 5-8, and 10, Takano teaches:

1. A method of reproducing information in a client/server system, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing an information recording medium containing characteristic information and having other information recorded thereon (See e.g. Fig. 11);

a client obtaining the characteristic information of the information recording medium (See Fig. 7, S701, "Read card management information" where, as shown in Fig. 1, the depicted "kiosk returning terminal" 110 is a client of a "kiosk management server" 170);

the client transmitting the characteristic information to a server (See e.g. Fig. 7, S702, "Transmit card management information and own terminal information to distribution center via kiosk management server" and Fig. 1);

the server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S801, "Receive card management information" and S803, "Obtain/calculate and prepare user name, program title, usage period, information of additional fee");

subsequently, the server transmitting information based on the usage information to the client (See e.g. Fig. 7, S703, "Receive information from distribution center via kiosk management server" and [0080], "In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110"); and

subsequently, the client reproducing the other information recorded on the information recording medium in accordance with the information based on the usage information (See e.g.

Fig. 7, S704 and [0081], "Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704").

2. A method of reproducing information using an information recording medium in a client/server system, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing a second server containing second information (See e.g. Fig. 1, "Kiosk Management Server" 170);

subsequently, a client obtaining characteristic information of the information recording medium (See Fig. 7, S701, "Read card management information" where, as shown in Fig. 1, the depicted "kiosk returning terminal" 110 is a client of a "kiosk management server" 170);

the client transmitting the characteristic information to a first server (See e.g. Fig. 7, S702, "Transmit card management information and own terminal information to distribution center via kiosk management server" and Fig. 1, where the claimed "first server" is the referenced "Distribution Center" 101);

the first server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S801, "Receive card management information" and S803, "Obtain/calculate and prepare user name, program title, usage period, information of additional fee");

the first server transmitting first information based on the usage information to the second server (See e.g. Fig. 8 and [0080], "In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110" where the claimed "second server" is the referenced "kiosk management server" 170);

the second server transmitting said second information to the client in accordance with the first information based on the usage information (See e.g. Figs. 7-8 and [0080], “In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110”); and

the client reproducing the information based on the second information received from the second server (See e.g. Fig. 7, S704 and [0081], “Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704”).

3. The method as claimed in claim 2, wherein the client transmits the characteristic information to the first server via the second server (See e.g. Fig. 7, S702, “Transmit card management information and own terminal information to distribution center via kiosk management server” where the claimed “first server” is the referenced “distribution center”).

4. (Canceled)

5. A server providing information to a client using an information recording medium in response to a request of the client, the server comprising (See e.g. Fig. 1, “Electronic Content Programs Distributing and Returning Center Server” 101):

a first part configured to receive characteristic information of the information recording medium from the client (See e.g. Fig. 8A, S801, “Receive card management information”);

a second part configured to obtain usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”); and



a third part configured to transmit to the client information on authorization of reproduction of information from the information recording medium based on the usage information, to enable the reproduction of said information from the information recording medium (See e.g. [0085], “When the title to be rented is determined, card information is transmitted to electronic content programs distributing and returning center server 101 in S934, user authentication is performed, payment of rental fee takes place and, thereafter, through large capacity communication unit 301, data is read and recorded on the card 150 from the electronic content programs distributing and returning center server 101” and Fig. 1).

6. The server as claimed in claim 5, further comprising:

a fourth part configured to receive from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], “When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811. When return condition is satisfied, the center server instructs erasure of the content program in S812. In response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “client” is the referenced “kiosk returning terminal”);

a fifth part configured to delete the usage information of the information recording medium based on the characteristic information (See e.g. [0082], “Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “usage information”, as shown in [0078], “Card management information stores a title, a rental due date and the like”, is included in the referenced “card management information”).

7. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of (See e.g. Figs. 1 and 7):

(a) receiving, based on a request of a client using an information recording medium, characteristic information of the information recording medium from the client (See e.g. Fig. 8A, S801, “Receive card management information”);

(b) obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A, S803, “Obtain/calculate and prepare user name, program title, usage period, information of additional fee”); and

(c) transmitting to the client information on authorization or reproduction of information from the information recording medium based on the usage information, and thereby enabling the reproduction of said information from the information recording medium (See e.g. [0085], “When the title to be rented is determined, card information is transmitted to electronic content programs distributing and returning center server 101 in S934, user authentication is performed, payment of rental fee takes place and, thereafter, through large capacity communication unit 301,

data is read and recorded on the card 150 from the electronic content programs distributing and returning center server 101” and Fig. 1).

8. The computer-readable recording medium as claimed in claim 7 wherein the method further comprises the steps of:

(d) receiving from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], “When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811. When return condition is satisfied, the center server instructs erasure of the content program in S812. In response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “client” is the referenced “kiosk returning terminal”); and

(e) deleting the usage information of the information recording medium based on the characteristic information (See e.g. [0082], “Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program” where the claimed “characteristic information” is the referenced “card management information” and the claimed “usage information”, as shown in [0078], “Card management information stores a

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title, a rental due date and the like”, is included in the referenced “card management information”).

9. (Canceled)

10. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of (See e.g. Figs. 1 and 7):

providing an information recording medium having characteristic information and other information recorded thereon (See e.g. Fig. 11);

subsequently, obtaining the characteristic information of the information recording medium (See Fig. 7, S701, “Read card management information” where, as shown in Fig. 1, the depicted “kiosk returning terminal” 110 is a client of a “kiosk management server” 170);

requesting a server to provide information and transmitting the characteristic information to the server so that the server obtains usage information of the information recording medium (See e.g. Fig. 7, S702, “Transmit card management information and own terminal information to distribution center via kiosk management server” and Fig. 1);

receiving information based on the usage information from the server (See e.g. Fig. 7, S703, “receive information from distribution center via kiosk management server”); and

subsequently, reproducing the other information recorded on the information recording medium in accordance with the information based on the usage information (See e.g. Fig. 7, S704 and [0081], “Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704”).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5-8, and 10 have been considered but are moot in view of the new grounds of rejection.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the information that is reproduced from the disk in Step S15 (Fig. 4B) is recorded on the disk 3 before the process is started") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dancs et al., U.S. Pat. 6,112,305; Kambayashi et al., U.S. P.A. Pub. 2002/0002466; Abe et al., U.S. P.A. Pub. 2002/0107595; Tobin et al., U.S. P.A. Pub. 2003/0014268; Hiltgen, U.S. P.A. Pub. 2003/0177353; Brew et al., U.S. P.A. Pub. 2003/0196114; and Nagai et al., U.S. P.A. Pub. 2005/0005141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Sanders whose telephone number is 571-270-1016. The examiner can normally be reached on M-Th 8:00a-5:00p.

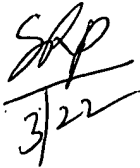
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vo Tim can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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